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EXAMINER LE, KHANH H				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/748,682

Applicant(s)

KONINGSTEIN, ROSS

Examiner

KHANH LE

Art Unit

3682

Period for Reply -- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/28/2010 and 03/08/2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-24,26-34,36-58,60-65,67-76 and 78-83 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1,3,5-24,26-34,36-58,60-65,67-76 and 78-83 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2011-03-08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 12/28/2010 (AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE) and 03/08/2011 (SUPPLEMENTAL RESPONSE) have been entered.

Claims 1-3, 5-24, 26-58, and 60-83 were pending as of the Office Action of June 30, 2010. Claims 2, 35, 66, and 77 have been canceled. Thus Claims 1, 3, 5-24, 26-34, 36-58, and 60-65, 67-76, 78-83 are now pending. (Claims 84-118 were withdrawn). Claims 1 (method), 34 (apparatus), 65 (method) and 76 (computer readable medium) are independent. Claims 1, 3, 5-11, 14, 16-21, 21, 27-34, 36-53, 56, 58, 60-65, 67, 71-76, and 78-83 have been amended.

2. The following previous rejections are withdrawn in view of the amendments that obviated them:

Claims 76-83 are rejected under 35 U.S.C. 101;
Claims 35-44, 50-54, 58, 60 under 35 U.S.C. 112, second paragraph;
claims 45-49, 56-57 under 35 U.S.C. 112, second paragraph;
claims 38-39, 44-55, 61-63, and 64 under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 112

3a. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3b. **Claims 1, 3, 5-24, 26-34, 36-58, and 60-65, 67-76, 78-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Currently Amended Representative Claim 1 recites:

A computer-implemented method comprising:

generating, at a server, an expandable advertisement comprising:

a compact display format including an associated expansion icon and a link to a landing page,

an expanded display format comprising the link to the landing page, a content portion, one or more content items, and one or more menu options associated with one or more respective content items, where each menu option, in response to a user selection, displays the one or more associated content items in the content portion, and

code that enables a client device to transition between the expanded display format and the compact display format upon a user request;

receiving a request for one or more advertisements (related to a subject matter of interest to be presented with content associated with a publisher); and

delivering in a single transmission, from the server to a client device, the expanded display format (in response to the request to be presented with the content associated with the publisher),

wherein the generating, receiving, and delivering are performed by one or more computers.

a) The limitation ***“delivering in a single transmission, from the server to a client device, the expanded display format”*** is confusing. In the interview of 6/15/11, Mr. Shepherd pointed to the following support, at paragraph [0068] of the published version of the Application US 20050096980,

” Upon selection or other indication by the user to transition the ad or morph the ad from a first display format to a second display format, a request may be processed solely at the end user system based upon the Java script described above. Accordingly, no further instruction to content/search and advertisement system may be required to transition the ad from a first display format to a second display format.”

Examiner stated that, based on that, there may be inherent support for *“delivering in a single transmission, ..the expandable advertisement”* rather than just the expanded display format.

Further claiming delivery of the expanded display format only, raises an indefiniteness issue: i.e. how did the expanded display format come about? did the user interact with the expandable ad? was the expandable ad and the compact display format delivered? was the compact display format delivered first and interacted with?

Thus the claim must be amended to at least *“delivering in a single transmission, ..the expandable advertisement”* rather than just the expanded display format. Further the claim must clarify that the user interacted with the compact display format of the expandable advertisement ,

and the expanded display format was displayed, in order to tie the “delivering” step to the “generating” step.

For prior art application, an interpretation of the above limitation is “*delivering in a single transmission, the expandable advertisement,*” is “*delivering the expandable advertisement, by using javascript or like codes that allow not having to go back to the server for the expanded display format*”.

Further, as stated in the Interview summary, what is “*in response to the request to be presented with the content associated with the publisher,*” in the phrase “*delivering in a single transmission, from the server to a client device, the expanded display format in response to the request to be presented with the content associated with the publisher,*”?

Is it the same request as in “*receiving a request for one or more advertisements (related to a subject matter of interest to be presented with content associated with a publisher)*”?

Mr. Shepherd said yes, it is, and probably to clarify that it is in response to the same request in the “receiving” step, the limitation may be amended to “*delivering ... from the server to a client device, .. in response to the request for the one or more advertisements to be presented with the content associated with the publisher*”.

(The Examiner notes that Mr. Shepherd subsequently sent another proposed amendment on 6/15/11 that improved on the above language, yet still has not put the claims in condition for allowance).

b) Further “*in the content portion*” in the phrase “*displays the one or more associated content items in the content portion*”, specifically in the phrase “*an expanded display format comprising the link to the landing page, a content portion, one or more content items, and one or more menu options associated with one or more respective content items, where each menu option, in response to a user selection, displays the one or more associated content items in the content portion*”, is not clear.

This phrase is understood as “in response to a user selection (of a menu option), it is displayed the one or more content items associated with the menu option, **in the content portion of the expanded display format. Examiner cannot find such a feature in the specification.**

Considering the specification, item 250 of Figure 2 shows the expanded format before menu selection. Figure 7 shows display of the expanded format after selection of a menu option from the expanded format of Figure 2.

It is taken that “*the content portion of the expanded display format*” is the area where items 260, 280 and 290 of Figure 2 reside. These latter being the claimed “one or more content items”. Menu options are items 230, 240 of Figure 2. Upon selection menu option 230 “*pictures*”, the pictures “*whales*”, “*boats*”, “*lighthouses*”(the claimed “*one or more associated*

content items” with the menu options) are shown adjacent to the expanded format, (item 200 of Figure 7) but not in the content portion of the expanded format, as claimed.

Since there is no proper support for the claim limitation, the claim is indefinite.

Independent claims 34, 65, and 76 have similar language and are rejected on the basis. All dependent claims are rejected based on their dependency of a rejected claim. Appropriate correction is required.

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Claim Rejections - 35 USC § 112

4a. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4b. Claim 1, 3, 5-24, 26-34, 36-58, and 60-65, 67-76, 78-83 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1:

As stated above, (see discussion of second paragraph of 35 U.S.C. 112), clear support cannot be found for “*in the content portion*” in the phrase “*displays the one or more associated content items in the content portion*”, in the phrase related to the “*expanded display format*”.

Independent claims 34, 65, and 76 have similar language and are rejected on the basis. All dependent claims are rejected based on their dependency of a rejected claim. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5a. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5b. Claims 1, 3, 5-12, 26, 28, 34, 36-43, 56, 58, 60, 65, 67-70, 71, 73 -74 and 76, 78-80, 82-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petropoulos et al. (US 2003/0146939 A1) (hereinafter Petropoulos) in view of Official Notice (with e.g. Meisel 7035812, herein Meisel, or Patel US US-2004/0103024, herein Patel, as support thereof).

Claims 1, 5, 34, 65 and 76:

Petropoulos discloses:

A computer-implemented method comprising:

receiving a request for one or more advertisements related to a subject matter of interest to be presented (on a webpage) with content associated with a publisher (Fig 7, item 751: "query" or "search"; [0073]);

delivering at one time, or in a single transmission, from the server to an end user device, in response to the request to be presented (on the webpage) **with content** associated with the publisher (*e.g. the search results page shown in Figure 1 is considered a webpage with content associated with the publisher, the content being other search results, ads, or other logos or insignias that commonly appear on a published webpage. Note that Official Notice is taken that it is old and well-known a published webpage commonly have other logos or insignias featured thereon such as a Yahoo page would have at least the yahoo logo*)

a expandable advertisement advertisement

including:

a compact display format including an associated expansion icon and a link to a landing page,

an expanded display format comprising:

the link to the landing page (see e.g. [0042]: e.g. hyperlinks in preview window allows retrieving more information; [0010]);

a content portion ([0042]: “the user can dynamically control the location of the preview window, its size and the duration of its visibility”: size being as large as desired reads on a content portion as large as desired; also see Fig 4 , large preview window);

one or more content items (e.g. Figure 1 item 58: “boeing corp”; “home” “investors”, “customers” is each content item; also with the large size of the preview window, it would have been obvious, more than one items of content is suggested by PETROPOULOS); and

one or more menu options associated with one or more respective content items, where each menu option, in response to a user selection, displays the one or more associated content items (see discussion regarding menu options below)
in the content portion, and

code that enables a client device to transition between the expanded display format and the compact display format upon a user request (Fig 1, items 60, 53, 54 are expandable ads in a search result lists content page because mousing over or clicking them (i.e. using embedded instructions which read on the claimed code and instructions) allows viewing preview information such as image 57 of Figure 1 (which reads on the second display format); or allows viewing lists of URLs that can be expanded further; or sortable webpages (which also read on the second display format) (see [0026-0027]; [0029]). Also see [0042] which discusses preview window 55 of Fig 1 (which also reads on the second display format) obtained by mousing over a first display format such as Fig 1, items 60, 53, or 54. Also see e.g. abstract, [0025]); [0023] “The defined areas are program-designated (perhaps with JavaScript) areas on results page 59” reads on providing code enabling the transition from format 1 to format 2:

[0023] Referring back to search-result page 59 as a whole, recall that this is a result returned after a user has performed a search on the term “Jet.” The user must then analyze those results and will typically do so using the combinations of keystrokes and the pointer tool. A feature of the current invention is that the user is shown preview information when the mouse pointer 52 navigates or passes over a defined area such as first defined area 60, second defined area 61, or other defined areas 62, 64, 66, 67, 68 (Hereinafter, the action of navigating or passing the mouse pointer over a region is referred to as a “mouse-over”). **The defined areas are program-designated (perhaps with JavaScript) areas on results page 59.** While these defined areas could be made visible, they are generally invisible to the user. **In one embodiment**, upon a

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pre-defined placement or action of the pointer (e.g. a mouse-over), instructions are sent to the user's web browser to automatically open an embedded preview window and render the relevant contextual information inline with the user's results. In various implementations of the invention, defined areas may be in any shape or size, located anywhere on the page and may be configured by a programmer, the user, or any process with sufficient access to the system.

An advertisement is a file or set of files. In PETROPOULOS, the advertisement is considered a file or set of files, comprising the totality of data about format 1 (search result), data about format 2 (preview window), including their contents, and functionalities such as the expansion icon and code such as the JavaScript in PETROPOULOS 's [0023] *"The defined areas are program-designated (perhaps with JavaScript) areas on results page 59"* which enables the transition from format 1 to format 2 (i.e. compact and expanded formats). All this data, instructions and code are inherently sent from a server to end user to allow display as disclosed in PETROPOULOS.

(As discussed earlier during prosecution, since the PETROPOULOS's preview window gives details about the search result, and both concern the same subject matter, both are interpreted as concerning, and thus as being, part of the same advertisement. The search result is interpreted as the compact format of the advertisement while the preview is interpreted as the expanded format of the same advertisement).

(As discussed earlier during prosecution, format 2 "embedded preview window" suggests some data about the preview window was delivered with the publishers webpage. Since the publishers webpage was delivered with the search result (1st or compact format) and data re. the instructions (e.g. the Javascript, see [0023], [0054]) as well as re. the 2nd or expanded format (see e.g. [0054]) are also on the publishers webpage, thus all 3 components of the ad are interpreted as necessarily delivered together in a single transmission).

PETROPOULOS also discloses:
the advertisement comprises menu options comprising a link to at least one other web page that enable the user to request additional content(e.g. [0028]; [0029]: *see discussion re. "cascading concept" and "directory structure" which read on menu options; [0030]: more search results reading on a menu; [0032]: preview information can be an advertisement with inherent links; [0042]: preview information include hyperlinks for mouse over or click on; or [0054], user may initiate a menu or control system for controlling the function of the available preview functions).*

(Note that PETROPOULOS also teaches many formats (e.g. in size, location, duration, opacity) that the preview window can take, e.g. at [0042],

"The invention contemplates that the preview information may be displayed in any manner that the client system may facilitate. ... the preview information may also be displayed in one or more new browser windows opened under or over the current window or in a window which already exists on results page 59 such as preview window 55, which can be located anywhere on results page 59...., the invention contemplates that the user can dynamically control the location of the preview window, its size and the duration of its visibility. " the user can dynamically control the location of the preview window, its size and the duration of its visibility." The preview window may cover "whatever information is below it on the (results) web page." .. "either completely, in opaque fashion or semi-translucent fashion. ". See [0049] and Fig 3).

PETROPOULOS does not disclose explicitly generation at the server of the ad including format 1, format 2 (i.e. compact and expanded) and code or instructions allowing transition between the two formats, as claimed.

However it would have been obvious to one having ordinary skill in the art at the time of the invention (herein a "PHOSITA") that such advertisement would have to be generated before it can be sent to end user devices and to display as disclosed in PETROPOULOS.

As stated earlier during prosecution, an ad with code or instructions is only a set of files. PETROPOULOS discloses at Fig 6, and [0064] a network of servers and other appliances connected to the end users by networks including the internet.

(Also as stated earlier , PETROPOULOS is interpreted as disclosing storing a plurality of advertisements associated with one or more subject matters of interest to users, the plurality of advertisements comprising at least one expandable advertisement (Fig 1, items 60, 53, 54 are expandable ads in a search result lists; Fig 7, item 753: data store; [0073]: search results made of documents or WebPages relevant to a subject searched are interpreted to include advertisements which are stored in data store 753) thus generation of the ad before storing, is obvious).

Thus it would have been obvious that the ad files as disclosed by PETROPOULOS above would have to be generated at some server to be sent to PETROPOULOS 's end user.

Further, if generation were to be interpreted as generation by an advertiser using an advertiser interface to input data relevant to the ad, Official Notice is taken that advertiser interfaces enabling advertisers to input and/or modify/edit various advertisement data used for publication on publishers webpages are old and well-known at the time of the invention. For example, see Meisel 7035812 (see abstract; Figs 2, 9 and associated text); Patel US-2004/0103024 (see abstract, Figures 21, 22 and associated text; also see Figures 3, 17, 18).

Thus it would have been obvious to a PHOSITA to add the advertiser interfaces as well known and used in the prior art (e.g. Meisel, Patel) to PETROPOULOS and modify them

accordingly to allow the PETROPOULOS 's advertisers to input all necessary data to render the ad with the compact and expanded formats using the codes and instructions as disclosed in PETROPOULOS. In view of the level of skill evidenced in at least the above cited references a PHOSITA would have known to modify the advertiser interfaces accordingly.

Further the system of PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) , as discussed above, also discloses wherein the generating, receiving, and delivering are performed by one or more computers (citations above).

PETROPOULOS further discloses:

claims 3, 36 (dependent on claims 1, 34):

wherein the additional information comprises one or more images (see e.g. [0032]; Fig 1, item "57");

claim 37 (dependent on claim 36):

wherein the additional information comprises menu options comprising a link to at least one other web page that enable the user to request additional content(e.g. [0028]; [0029]; see discussion re. "cascading concept" and "directory structure" which read on menu options; [0030]; more search results reading on a menu; [0032]; preview information can be an advertisement with inherent links; [0042]; preview information include hyperlinks for mouse over or click on; or [0054], user may initiate a menu or control system for controlling the function of the available preview functions);

claims 6, 38 (dependent on claims 1 , 37):

wherein the options, upon selection, retrieve web content specified in association with the expandable advertisement delivered (e.g. [0028]; [0029]; see discussion re. "cascading concept" and "directory structure" which read on menu options; [0030]; more search results);

claims 7, 39 (dependent on claims 6, 38):

wherein the content retrieved comprises content provided by or affiliated with a host entity that performs the storing, receiving and delivering steps ([0025-26], preview information displays actual content or the web page referred by or associated with the first result delivered by the host entity; or [0029]; further contextual information re. URL pertaining to web page);

claims 8-9, 40, 67 and 78 (dependent on claims 2, 35, 65 and 76):

wherein the additional information comprises audio elements ([0043]) or an animation ([0043]: “any other sensory information” reads on including animation);

claims 10, 41, 68, and 79 (dependent on claims 1, 34, 65 and 76):

wherein the one or more user requests comprises selection of an expansion icon presented as part of the first display format ([0037]-[0038]: preview icons, Fig. 1, items 63 or 64, used to open (i.e. expand to) preview pane 57 when moused over or clicked);

claims 11, 42, 69, and 80 (dependent on claims 1, 34, 65 and 76):

wherein the one or more user requests comprises a mouse-over of the first display format (e.g. [0038], user mousing over display icon to open preview display; or [0036]: mousing over defined area 60 of Fig 1 opens webpage 57);

claims 12, 43, and 70 (dependent on claims 1, 34, and 65):

wherein the one or more user requests (interpreted as “to display the second format”) comprises a preference specified by the user ([0038], line 5: “user options” or [0042]: user may control attributes of preview window).;

claims 56, 71 (dependent on claims 1, 34, and 65):

wherein the instructions include data sufficient to enable the end user system to display the contents of the second display format (Petropoulos implicitly discloses such instructions to allow interpreting user action such as mouse over of the electronic ad and displaying the second display format, as discussed in e.g. [0042]: preview information displayed over the current window or in a window which already exists on results page such as a preview window that can be located anywhere on the results page);

claim 26 (dependent on claims 25):

wherein the second display format comprises a graphic (e.g. Fig 1 item 57);

claims 28, 58, 73 -74 and 82-83 (dependent on claims 1, 34, 65, 76):

wherein the second display format covers different area in an interface of the end user system than the first display format (e.g. Figs 2 or 3, preview window is different from search results window that reads on first display format as well); wherein 2nd display format covers more area than 1st display format (for claims 82, 73) (Petropoulos, e.g. [0027]; [0037]); wherein 2nd display format covers one or more advertisements (for claims 74, 83) (Petropoulos, e.g. [0027]; [0037]);

claim 60 (dependent on claim 44):

wherein the second display format covers a different location than the first display format (e.g. location of Fig 1 item 55 (2nd display format) as compared to location of items 53, 54 (first display format)).

5c. Claims 33, 64, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petropoulos et al. in view of Official Notice (with e.g. Meisel 7035812 or Patel US 2004/0103024 as support thereof).

Claims 33, 64, and 75 (dependent on claims 1, 34, and 65):

PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) disclose claims 1, 34, and 65.

Petropoulos further discloses second display formats are approved prior to being delivered ([0042], last few lines: filtering (i.e. approval) for content appropriateness in second display formats before transmission; [0032], last sentences: web page creators control second display formats with tags).

However neither PETROPOULOS nor the Official Notice explicitly disclose such controls or approval applicable to the first display formats.

However in the system of Petropoulos in view of Official Notice, it would have been obvious to one having ordinary skill in the art at the time of the invention to apply the same controls or approval that PETROPOULOS teaches as to the second format, to the first display formats, for the same disclosed advantages.

5d. Claims 27, 57, 72, 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) as applied to claims 26, 56, 71, or 76 in view of Housman et al., US 20030224340 and further in view of Angelica US 20040239703.

Claims 27, 57, 72, 81 (dependent on claims 26, 56, 71, 76):

PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) discloses claims 26, 56, 71, 76 and PETROPOULOS discloses wherein the second display format comprises a graphic (e.g. Fig 1 item 57); however it is not disclosed wherein the instructions include an instruction to preload the graphic before an end user request to display the second display format.

However Housman teaches preloading requested images would increase display speed ([0054]).

Thus it would have been obvious to a PHOSITA to add this Housman teaching to PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) because “[t]his obviously is much faster than having the user wait for his potentially-slow communications link to download the next requested answer” (Housman, [0054]).

Further Angelica US 20040239703 A1 in a system for expanding computer display advertising discloses java code for preloading graphics. See [0075]. Thus it would have been obvious to a PHOSITA to add code instructions as taught by Angelica to the above system to allow preloading the graphics.

5e. Claims 13-24, 44-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) as applied to claims 1 or 34 above, and further in view of Meisel 7035812.

Claims 13, 44:

PETROPOULOS in view of Official Notice (with e.g. Meisel 7035812 or Patel US US-2004/0103024 as support thereof) discloses a method as in Claim 1 or 34 above and discloses monitoring user interaction with the preview information (including length of interaction; clicks: [0073]) in order to revise the original rankings (based on relevance) of search results ([0072]-[0079]).

PETROPOULOS does not explicitly disclose search results ranked by monetary considerations, thus does not explicitly disclose:

storing a price parameter (in association with one or more advertisements) (interpreted as e.g. a cost per click or CPC) for certain performance by end users viewing the advertisement (interpreted as e.g. a click);

and upon receiving a request for an advertisement, determining one or more advertisements to deliver based at least in part on the price parameter (associated with a plurality of advertisements associated with the subject matter of interest).

But Meisel does (see e.g. abstract: “bid amount” is interpreted as cost per click).

Thus it would have been obvious to one having ordinary skill in the art at the time of the invention to add Meisel's bidding system to the system of PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) to allow also ranking search results based on monetary considerations.

Claims 14, 45 (dependent on claims 13, 44):

Note: "granting a ranking bonus for expandable advertisements" is interpreted as giving advertisers a bonus in order to encourage them to use expandable ads as per specification at paragraph [0093].

PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) and MEISEL disclose a method as in Claim 13, 44 above and but neither discloses granting a ranking bonus for expandable advertisements in determining the one or more advertisements to deliver.

Official Notice is taken that is old and well-known at the time of the invention to give incentives to encourage customers to try new products or services or new features thereof. See e.g. Partovi, US 20020126813 A1 (abstract: incentives for trying new phone features).

Thus in the search listings business, since ranking is valuable to advertisers, it would have been obvious to one having ordinary skill in the art at the time of the invention (herein a "PHOSITA") to give an incentive tied to rankings to encourage advertisers to use the new form of expandable advertisement until they can be convinced of its effectiveness.

Claims 15, 46 (dependent on claims 13, 44):

PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) and MEISEL disclose a method as in Claims 13, 44 above. PETROPOULOS does not but Meisel does teach the determining step determines ranking of advertisements based on an effective revenue per impression determined based on bid amount and click-through-rate ("effective revenue per impression" is interpreted as a product of click through rate and cost per click, also called ecpm or ecpc. Meisel at col. 19 lines 45-55: each bid can be expressed in units of ecpm or ecpc. Since ranking in Meisel is based on bids, thus ranking is based ecpm or ecpc). Thus it would have been obvious to a PHOSITA to add this feature of Meisel to PETROPOULOS to allow ranking per effective revenue per impression.

Claims 16-17, 47-48:

PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) and MEISEL disclose a method as in Claims 15, 46 above. Neither teach comprising the step of

granting a bonus for expandable advertisements by taking an action causing a change to (or enhancing) the effective revenue per impression (or a price parameter) for the expandable advertisement.

Official Notice is taken that is old and well-known at the time of the invention to give incentives (or bonuses) to encourage customers to try new products or services or new features thereof. See e.g. Partovi, US 20020126813 A1 (abstract: incentives for trying new phone features).

Thus in the search listings business, since ads ranking is valuable to advertisers, and since ecpm (effective revenue per impression) determines rankings (see Meisel in discussion of claim 15 and 46 above), it would further been obvious to a PHOSITA that the bonus could be expressed in advantageous ecpm terms, (e.g. by increasing the ecpm for a particular ad based on which its ranking is determined without increasing the charge to the advertiser) thereby advantageously affect the rankings for ads using the new expandable ad format.

Claims 18, 49:

PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) and MEISEL disclose a method as in Claims 17, 48 above. Neither explicitly teaches wherein the advertiser is charged based on the price parameter but not the increased price parameter value when the expandable advertisement achieves one or more performance parameters (e.g. when the end user clicks on a expandable ad). However as discussed above in claims 16-17, 47-48, a bonus is given to advertisers to try the new expandable ad format, in forms of an enhanced ecpm that advantageously influence that ranking. Thus it would have been obvious to a PHOSITA that the advertiser of PETROPOULOS and MEISEL should only be charged the price parameter based on her bid (and not the enhanced or increased price parameter value), otherwise the bonus would have been negated.

Claims 19, 50:

PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) and MEISEL disclose a method as in Claims 13, 44 above. Neither explicitly teaches the advertiser is charged an increased amount for a expandable advertisement. However it would have been obvious to a PHOSITA to charge more for the expandable advertisement if it later proves to be an effective format and demand from advertisers allows, and/or its cost of production justifies, increasing its price.

Claims 20-21, 23, 51-52, 54:

PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) and MEISEL disclose a method as in Claims 13, 44 above. Neither explicitly teaches calculating

an amount owed by an advertiser associated with an advertisement based on the advertisement meeting a performance parameter associated with the expandable advertisement, wherein the performance parameter is determined based on user activity associated with the second display format, or based on user request to view the second display format.

However PETROPOULOS teaches tracking user behavior pertaining to the second display format (i.e. a performance parameter is met as to the expandable ad and/or second display format) ([0042]:” functional attributes of preview window include the use of a scroll bar, hyperlinks that a user can mouse over or click on which would result in a call to the referenced page”;[0073]; also see ([0026], preview information include URLs as links; [0054]: menu or control system for controlling the function of the available preview functions).

Further Meisel teaches billing advertisers based on their bids (abstract).

Thus it would have been obvious to a PHOSITA, in the PETROPOULOS and MEISEL system, to bill the advertiser (or calculate an amount owed by an advertiser as claimed) when an end user interacts with (e.g. by clicking) the expandable ad and the second display format of the system (i.e. based on the expandable advertisement meeting a performance parameter as claimed) in order to collect revenues for the ad service.

Claims 22, 53:

PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) and MEISEL disclose a method as in Claims 21, and 52 above. Neither explicitly teaches the billing is based on the user activity comprising a predetermined period of time viewing the second display format. However Petropoulos further discloses wherein the user activity comprises a predetermined period of time viewing the second display format ([0042], user can dynamically control the duration of the preview window visibility, see also [0073-75], user’s use of preview information monitored including the length of each preview, a long duration indicates high relevancy to a particular result). **Further Official Notice is taken** that it is old and well-known at the time of the invention that billing an advertiser for an amount of time the user interacts with an advertisement is **old and well-known** at invention time (e.g. see **Faber, US 20050114210** , at [0070]). Thus in the system of PETROPOULOS and MEISEL, it would have been obvious to a PHOSITA to charge advertisers based on a predetermined time of user interaction (as is well-known) and which can be tracked as taught by PETROPOULOS for the purpose of billing based on this well-known measurable value basis.

Claims 24, 55:

PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) and MEISEL disclose a method as in Claims 21, and 52 above. Neither PETROPOULOS or

MEISEL teaches the user activity comprises a predetermined number of user selections of menu options, navigational links or other controls available in the second display format. However Petropoulos discloses wherein the user activity comprises a predetermined number of user selections of the one or more menu options available in the second display format ([0026], preview information include URLs, with respect to URLs used as preview information these URLs will function as links, see also [0054], user may initiate a menu or control system for controlling the function of the available preview functions).

Thus in the system of PETROPOULOS and MEISEL, it would have been obvious to a PHOSITA to charge advertisers based on all the user behaviors cited above which can be tracked in PETROPOULOS for the purpose of billing based on specified user behavior which may indicate different levels of interaction with the expandable ad and/or second display format which may be of different values to the advertisers.

5f. Claims 29-32, 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) , in view of Meisel, as applied to Claims 28, 34 above and further in view of Telagon, US 20030135460.

Claims 29-32, 61-63:

PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) discloses a method as in Claims 28, 34 above and MEISEL further discloses an ad priority scheme based on bid prices (see discussion at paragraph 13 above) thus the combination of PETROPOULOS and MEISEL discloses the steps of: storing a price parameter value in association with one or more advertisements when the advertisement meets one or more performance parameters with respect to the end user; upon receiving a request for an advertisement, determining one or more advertisements to deliver , in a priority scheme, based at least in part on the price parameter associated with a plurality of advertisements associated with the subject matter of interest; and wherein the step of determining includes assessing whether to deliver a expandable advertisement based on the price parameter of the expandable advertisement (citations and discussion at paragraph 13 above).

PETROPOULOS in view of Official Notice (with e.g. Meisel or Patel as support thereof) and MEISEL do not disclose delivery of the expandable advertisement is also based on:

“the price parameter value of at least one other advertisement and at least one area-based parameter” ; or

further “wherein the area-based parameter comprises the price parameter value of at least one advertisement that the second display format would cover upon user request”; or

wherein the expandable advertisement may cover one or more other advertisements, the price parameter value associated with each other advertisement that the second display format covers plus a premium amount.

However Telagon, in a system for valuing and placing ads, teaches the concept that an advertiser paying more should have more exposure within a limited ad space ([0039]; [0045]). Telagon gives the example that if there are 6 ad segments or displays available within an ad space, an advertiser bidding \$20 while four others bid \$10 dollars each, should get two/sixth of the available ad segments [0045].

Thus Telagon teaches the ad price is directly proportional to the ad space covered by the ad i.e. proportional to the real estate used by the ad. Thus it would have been obvious to a PHOSITA to add this concept taught by Telagon to PETROPOULOS and MEISEL in order to fairly price the advantage given to an expanding ad that covers other ads. It would further have been logical and thus obvious that if an ad, e.g. ad #1, should expand and cover another ad (e.g. ad#2) then that ad #1, would also have to pay, in addition to its own bid price, the price that ad #2 would otherwise have fetched, because of the benefit to ad #1 and the detriment to ad #2. By the same token if further expansions of ad#1 are requested thus covering other ads (e.g. ad#3 to ad #n), it would have been further obvious to a PHOSITA, that the charge to ad #1 should and could be increased to cover the bids of ad#3 to ad #n, again because of the benefit to ad #1 and the detriment to ad #3 to ad #n. (Also since duplication of parts has been held obvious, here, duplication of charges for ad #3 to ad #n would have been obvious as mere duplications of charges of ad #2).

Further it is well-known parties to a contract can agree to any contractual terms, including compensation terms, for any purpose. Thus to add a premium as claimed would have been an obvious matter of design choice, only subject to agreement by the parties, for the purpose, e.g. to make a better profit for the ad service.

Response to Arguments

6. Applicant's arguments filed 03/08/2011 have been fully considered but they are not persuasive. To the extent that any of Applicant's arguments filed on 05/05/2010 still apply, for brevity, the Examiner's responses thereto, in the last Office Action filed 06/28/10 ("06/28/10 OA", are herein incorporated in full. (Examiner notes it is no longer claimed that the expanded display format displays while no longer displaying the compact display format. If this feature is still contemplated by Applicant, Applicant is referred to the 06/28/10 OA as well.

As to "in a single transmission" as stated above, it is understood that it is the Javascript code embedded in the HTML page is what allows not going back to the server to fetch the expanded display format. (In interview of 6/15/11, Mr. Shepherd pointed to paragraph [0068] of the published version of the Application US 20050096980 as support therefor).

As stated earlier during prosecution, the embedded code of Petropoulos (e.g. the Javascript, see [0023], [0054]) allows moving between the 2 formats. Thus inasmuch as Applicant's javascript code can be said to allow "single transmission", Petropoulos javascript code is interpreted as disclosing same.

Applicant argues that " *while a landing page may itself include one or more links, those links would not be the same link as the link that is included in a web page search result (i.e., a landing page would not include a link to itself).* " In the interview of 06/15/11, Applicant told the Examiner what he meant by the claims, that is, Figure 1 item 105 is the "compact display format ...including a link to a landing page", this latter being www.wildlands.com, Figure 2 item 290 is the "expanded display format comprising the link to the (same) landing page". www.wildlands.com.

However, contrary to argument, the following Petropoulos disclosure also reads on a compact display format including an associated expansion icon and a link to a landing page (Figure 1 item 53, www.jetprop.com) ; and an expanded display format comprising the link to the landing page (Figure 1 item 57, www.jetprop.com).

Applicant also argues: "*Further, the relied upon portions of Petropoulos do not describe or suggest one or more menu options associated with one or more respective content items, where each menu option, in response to a user selection, displays the one or more associated content items in the content portion.*"

However as stated earlier and above," PETROPOULOS does disclose the advertisement comprises menu options comprising a link to at least one other web page that enable the user to request additional content(e.g. [0028]; [0029]: see discussion re. "cascading concept" and "directory structure" which read on menu options; [0030]: more search results reading on a menu; [0032]: preview information can be an advertisement with inherent links; [0042]: preview information include hyperlinks for mouse over or click on; or [0054], user may initiate a menu or control system for controlling the function of the available preview functions)."

Applicant also argues the relied upon Official Notice does not disclose the newly amended claim limitations. However the Official Notice does not need to, since Petropoulos already disclose the limitation.

Lastly, the currently amended claims, as noted above,are indefinite, and prior art is applied to the claims as best understood. Applicants are courteously invited to contact the Examiner to further clarify possible allowable matter.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Monday-Wednesday 9:00-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boveja Namrata can be reached on 571-272-8105. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh H. Le/

Primary Examiner, Art Unit 3682